REMARKS

Claims 1-9 remain pending, and claims 4-6 are currently amended. No claims are canceled or added.

Claims 1-9 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The rejection originally issued in the first Office Action, and, despite applicants' arguments of June 23, 2005, the PTO maintains the rejection. Applicants explain herein why the current Office Action does not fully respond to applicants' arguments to justify the rejection.

First, the Office Action provides the statement, "The claims are not directed to programs on computer-readable media." However, 35 U.S.C. § 101 provides no basis for holding that a claim is non-statutory just because it is not directed to programs on computer-readable media. (For example, it should be undisputed that a claim to a shovel does not become non-statutory just because it is not directed to a program on a computer-readable medium.) Although it may be understood within the PTO that claims directed to programs on computer-readable media are statutory, it does not logically follow from such understanding that *only* claims of that type are statutory.

The Office Action also provides the statement, "The claims state no computer hardware to execute any programs that might exist on computer-readable media." However, as applicants explained in the submission dated June 23, 2005 on pages 9-10, under 35 U.S.C. § 112, sixth paragraph, an element in a claim for a combination expressed as a means or step for performing a function without the recital of structure or acts in support thereof shall be construed to cover the corresponding structure or acts described in the specification and equivalents thereof. Note the exemplary claim 1 element "means for loading a management application program ..." and its

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corresponding structure in the specification, for example, in the paragraph bridging pages 6 and 7 and elements 1 and P1 in Figs. 1 and 2. This disclosure clearly shows that claims 1-3 recite computer hardware that executes programs that might exist on computer-readable media. (Claims 4-9 are discussed below.)

Although the PTO maintains the rejection, it provides no response to the above argument relying on means-plus-function language and 35 U.S.C. § 112, sixth paragraph. Applicants respectfully submit that, if the PTO chooses to maintain the rejection, it should provide an explanation detailing what supposed flaw exists in the applicants' argument presented above.

Also, applicants' submission of June 23, 2005 on page 9 noted the recitation "management application program" in the claims, and the submission also noted the explanation in the specification, page 6, line 23, that a "management application program" may be stored in a disk device. In response, the recent Office Action provides the following:

> A "disk device" is not limited to tangible, statutory computer-readable media.
> Applicant still claims software, *per se*.

Applicants respectfully disagree. The term "disk device" is notoriously well known in the art to denote a computer-readable medium, and the Office Action provides no example of "disk device" used in reference to a non-statutory device. Also, the statute 35 U.S.C. § 101 does not mandate that a claim is non-statutory simply because a term therein may be used somewhere, out of the context of the corresponding disclosure, to describe software. Applicants have shown that, in the context of the present application, the term "disk device" is used to describe a computer-readable medium.

Applicants can infer from the statement in the Office Action that perhaps the intent was to state that the claims do not explicitly recite "disk device." However, claims 1-3 explicitly

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recite other elements, such as "means for loading a management application program ...," so the claims do not need to recite "disk device" to be statutory.

Applicants respectfully submit that, unless a response can be provided addressing the remarks above, the rejection of claims 1-3 under 35 U.S.C. § 101 should be withdrawn.

Regarding claims 4-9, applicants reference, as an example, the first step recited in claim 4, which now recites, "using said manger to load and execute a management application program." (The previous version of the claim recited "allowing" in place of "using.") Applicants had argued in their submission of June 23, 2005 that the corresponding acts in the specification (see, for example, the paragraph bridging pages 6 and 7 and elements 1, 3, and P1 in Figs. 1-3) clearly showed that this step describes a program on computer-readable media. However, as noted above, the Office Action responds with the following statements:

> The claims are not directed to programs on computer-readable media. The claims
> state no computer hardware to execute any programs that might exist on
> computer-readable media.

Applicants discuss above why these statements do not support the rejection of the system claims. For analogous reasons, they do not support the rejection of the method claims.

In view of applicants' remarks, withdrawal of the rejection under 35 U.S.C. § 101 is now solicited.

Claims 1, 4, and 7-9 stand rejected under 35 U.S.C. § 102(e) as anticipated by Mayton et al., U.S. Patent No. 6,763,380.[1] Applicants respectfully traverse this rejection, because the reference does not teach all subject matter claimed.

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[1] The Office Action indicates on page 2 that claims 1 and 4 are rejected, and the Office Action implies on page 3 that claims 7-9 are also rejected on the same grounds.

In the submission of June 23, 2005, applicants identified subject matter recited in the claims and missing from Mayton et al. Specifically, applicants noted that claim 1 described a traffic management system comprising a manager that has:

> means for delivering a traffic analysis program to each of said active monitors,

and applicants also noted that claim 4 describes a traffic monitoring method having steps of both:

> allowing said manager to request said active monitors to load a traffic analysis program,

and

> allowing said active monitors to load and execute the traffic analysis program in response to said load request.

Claims 7-9, which depend from claim 4, also recite this subject matter.

Given that the claims recite "manager" and "active monitors," the PTO is obligated to support any anticipation rejection of these claims by indicating which elements disclosed by Mayton et al. supposedly teach a "manager" and "active monitors." However, the PTO does not provide such indication in the recent Office Action. Instead, the PTO only provides citations to blocks of text as relating generally to the claims as a whole.

(Applicants recognize the possibility that the PTO is relying on console node 20 to teach the manager and on endpoint nodes 14-18 to teach the active monitors. However, without an explicit statement to this effect, the rejection has not been fully justified.)

Even if the PTO did identify the elements of Mayton et al., which are relied upon to teach a manager and active monitors in a network, the anticipation rejection would still not be fully justified without explaining how:

> (1)   the manager had means for delivering a traffic analysis program to each of the active monitors,

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(2)   the manager were allowed (or "used," as now claimed) to request that the active monitors load a traffic analysis program, and

(3)   the active monitors were allowed (or used) to load and execute the traffic analysis program in response to the load request.

The explanation provided in the Office Action, page 3, is that Mayton et al. discloses active monitor nodes running a traffic monitoring program, analyzing traffic, and sending the results to the console node, a manager, in response to a request. (The Office Action does not state which elements of Mayton et al. are "active monitor nodes," but applicants acknowledge that Mayton et al. recites "active monitor" in column 9, line 63.)

However, instead of indicating a disclosure in Mayton et al. of a manager delivering a traffic analysis program to a monitor, the PTO deems this characteristic *inherent* in active networking. Accordingly, applicants quote from the Manual of Patent Examining Procedure (MPEP) regarding the specific requirements incumbent upon the PTO, when it relies on inherency to justify an anticipation rejection.

MPEP § 2112, IV states: "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill" (emphasis added and citations omitted). That is, for the PTO to justify the present anticipation rejection by arguing that it is inherent in the Mayton et al. system to deliver a traffic analysis program to a monitor from a manager, an Office Action must provide evidence recognized by persons of ordinary skill in the art that the Mayton et al. system *necessarily* delivers a traffic analysis program accordingly.

The evidence provided in the Office Action is an article by Tennenhouse et al. ("Toward an Active Network Architecture," Computer Communication Review) from 1996 (preceding the filing date of Mayton et al.), which begins with "Active networks allow their users to inject

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customized programs into the nodes of the network." (Abstract.)[2] Applicants acknowledge that the reference also states that active networks allow the network to perform customized computations on the user data. (Page 5, first column, last full paragraph.)

However, to determine, as required by MPEP § 2112, whether a person of ordinary skill in the art would have recognized that the Tennenhouse et al. article makes clear that a manager delivering a traffic analysis program to a monitor is *necessarily* a feature of the Mayton et al. system, the person of ordinary skill art would need to make the following two considerations: (1) whether the usage of the term "active" by Tennenhouse et al. effectively controls the later usage of that term by anyone else; and (2) whether the Mayton et al. document was written with the intention of using the term "active" exactly as used by Tennenhouse et al.

Regarding the first consideration, one skilled in the art, when reading Tennenhouse et al., would note the statement on page 6, top, that the document was written to present the authors' "vision of *an* active network architecture" (emphasis added). That is, although the authors thought of at least one type (the quoted text recited "an" instead of "all") of active network architecture, the authors did not claim to set a limiting definition of "active network architecture" that would apply to all documents ever written in the future, even those written by others, such as Mayton et al.

Regarding the second consideration, applicants find no statement in Mayton et al. that specifies or implies that the patent application was written with the intention of using the term "active" in the same way that Tennenhouse et al. used the term previously to describe *an* active

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[2] Note that the method claims no longer recite just the steps that the elements are "allowed" to do. Instead, the claims specify that the elements are actually used to perform those steps. Thus, a prior art teaching of what a system *allows* its components to do will not suffice to justify an anticipation rejection of claims that specify that the system actually *uses* the components.

network architecture. Certainly, the Office Action provides no justification for the inference that Mayton et al. uses the term "active" in the same way Tennenhouse et al. uses it.

Thus, in view of these two considerations, the Office Action has not shown that a person of ordinary skill in the art would have recognized that the Tennenhouse et al. article *makes clear* that a manager delivering a traffic analysis program to a monitor is necessarily a feature of the Mayton et al. system. Thus, under MPEP § 2112, Tennenhouse et al. does not establish that it is inherent in the Mayton et al. system that a manager delivers a traffic analysis program to a monitor.

Moreover, Mayton et al. strongly implies that its manager does *not* deliver a traffic analysis program to an active monitor. The Mayton et al. system operates instead as follows:

Console node 20 collects data from endpoint nodes 14-18 and analyzes the network based on the collected data. However, endpoint nodes 14-18 do not analyze the data themselves. It thus follows that console node 20 does not deliver a traffic analysis program to an active monitor. The basis for the preceding summary of the Mayton et al. operation is the following:

Mayton et al. discloses that console node 20 may operate to control initiation and scheduling of end point acquisition of data to provide text results for association with routing information between endpoint nodes 14-18. (Column 6, lines 2-6.) Based on this disclosure, console node 20 requires that endpoint nodes 14-18 begin the acquisition of traffic data, and control node 20 also controls the scheduling for the data acquisition. Then, console node 20 receives the data from endpoint nodes 14-18 and analyzes the data. Console node 20 may define a test schedule including test protocol for each connection to simulate communications traffic between a plurality of selected endpoint nodes 14-18. (Column 6, lines 56-59.) There is no

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disclosure that console node 20 sends the test protocol for the connection to the endpoint nodes 14-18.

In view of the cited portions of Mayton et al., Tennenhouse et al., and the MPEP, applicants submit that Tennenhouse et al. does not establish that it is inherent in the Mayton et al. system to deliver a traffic analysis program to a monitor from a manager. Accordingly, withdrawal of the anticipation rejection is now solicited.

Claims 2, 3, 5, and 6 stand rejected under 35 U.S.C. § 103(a) as obvious over Mayton et al. in view of Hanchett (U.S. Patent No. 6,834,301). Applicants respectfully traverse this rejection.

The rejection of claims 2, 3, 5, and 6 is based on Mayton et al. anticipating base claims 1 and 4. However, as explained above, the PTO has not justified the rejection of claims 1 and 4. Therefore, it has not justified the rejection of claims 2, 3, 5, and 6.
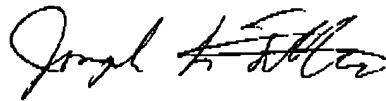
Accordingly, withdrawal of the obviousness rejection is now solicited.

In view of the remarks above, applicants now submit that the application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for any reason it is believed that this application is not now in condition for allowance, the Examiner is welcome to contact applicants' undersigned attorney at the telephone number indicated below to discuss resolution of the remaining issues.

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If this paper is not timely filed, applicants petition for an extension of time. The fee for

the extension, and any other fees that may be due, may be debited from Deposit Account No. 50-

2866.

Respectfully submitted,

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